

REMARKS

The application has been reviewed in light of the Office Action mailed on May 3, 2006. Claims 1-26 are currently pending in the application, with Claims 1, 9, 15, 20 and 25 being in independent form. By the present amendment, independent Claims 15, 20 and 25 have been amended and Claims 27 and 28 have been cancelled. No new matter is introduced into the claims by the amendments. In view of the amendments and remarks to follow, reconsideration and allowance of this application are respectfully requested.

Objection to Claims 27 and 28

Claims 27 and 28 were objected for informalities. Claims 27 and 28 have been cancelled. Withdrawal of the objection is respectfully requested.

Rejection of Claims 15-28 under 35 U.S.C. § 102

Claims 15-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshida (EP 0 335 656 A1). Applicants fully considered the Examiners' Response to Arguments on pages 12-15 and found the Examiner's response to be persuasive. Accordingly, Applicants have amended independent Claims 15, 20 and 25 to further define Applicants' claimed subject matter as directed to a system having a decoder for decoding data encoded by an image (Claim 15) and a method having the step of decoding data encoded by an image (Claims 20 and 25).

Yoshida is directed to an automatic focus control apparatus particularly suitable for use in **auto-focus television cameras** as stated throughout the written description of Yoshida. There is no disclosure or suggestion in Yoshida of a decoder for decoding data encoded by an image as recited by Applicants' Claim 15. Further, there is no disclosure or suggestion in Yoshida of decoding data encoded by an image as recited by Applicants' Claims 20 and 25.

The apparatus described by Yoshida comprises zoom lens 2; image pick-up means (i.e., image pick-up element 3, pre-amplifying circuit 4, signal processing circuit 5, and matrix circuit 6) for picking up an image of an object by means of zoom lens 2; amplitude value detecting means (i.e., band-pass filter circuits 7A, 7B, 7C, detecting circuits 8A, 8B, and 8C, selector switch 9 and A/D converter 12) for detecting the amplitude value of the color signals SB, SG and SR derived from the image pick-up means; and auto-focus control circuit 10. See column 3, lines 51-60 and FIG. 2.

It is respectfully submitted that Applicants' claimed subject matter as recited by Applicants' independent Claims 15, 20 and 25 is patentable over Yoshida. In particular, independent Claim 15 has been amended to recite "A system...comprising...a decoder for decoding data encoded by said image." Independent Claims 20 and 25 have been amended to recite "A method...comprising...decoding data encoded by said image."

Yoshida, as stated above, is directed to an automatic focus control apparatus particularly suitable for use in auto-focus television cameras. There is no disclosure or suggestion by Yoshida of a decoder for decoding data encoded by an image as recited by Applicants' Claim 15 or decoding data encoded by an image as recited by Applicants' Claims 20 and 25. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested and allowance of Claims 15, 20 and 25 is earnestly solicited.

Dependent Claims 16-19, 21-24 and 26 depend directly or indirectly from independent Claims 15, 20 and 25, and are therefore patentable for at least the reasons given above for independent Claims 15, 20 and 25. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested and allowance of the dependent claims is earnestly solicited.

Rejection of Claims 27 and 28 under 35 U.S.C. § 102

Claims 27 and 28 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,192,856 issued to Schaham. Claims 27 and 28 have been cancelled. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 1-14 under 35 U.S.C. § 103

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida. The rejection is respectfully traversed. It is respectfully submitted that independent Claims 1 and 9 are patentable over Yoshida.

In the Office Action, the Examiner asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Yoshida, the reader being an optical code reader; the target being an optical code; a decoder for decoding data encoded by said image, the processor for performing said analysis until data is decodable by said decoder; the optical code reader further comprising an illumination apparatus for illuminating a field of view, said field of view including the optical code; in order to take advantage of the improved auto-focus system and method as taught by Yoshida in an optical code reader.”

Applicants respectfully disagree with the Examiner’s assertions. As set forth in the MPEP Section 2143, to establish a prima facie case of obviousness (35 U.S.C. § 103), there are three basic requirements: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine the teachings; (2) a reasonable expectation of success; and (3) the reference(s) teach or suggest all of the claim limitations.

As stated above with respect to the 35 U.S.C. §102 rejection, Yoshida is directed to an automatic focus control apparatus **particularly suitable for use in auto-focus television cameras**. It is respectfully submitted that Yoshida fails to disclose or suggest all of the claim limitations recited by Applicants' Claims 1 and 9 as required by the third prong listed above in order to establish a prima facie case of obviousness. In particular, Yoshida fails to disclose or suggest an optical code reading system comprising and optical code reader for imaging an optical code as recited by Claim 1; a decoder for decoding data encoded by an image as recited by Claim 1; a method comprising the step of imaging an optical code as recited by Claim 9; and a method comprising the step of decoding data encoded by an image as recited by Claim 9.

It is also respectfully submitted that there is no suggestion or motivation as required by the second prong listed above in order to establish a prima facie case of obviousness, either in Yoshida or in the knowledge generally available to one of ordinary skill in the art at the time of the present invention, to modify Yoshida in order to provide an optical code reading system comprising an optical code reader for imaging an optical code; a signal processor comprising means for performing an analysis utilizing principles of axial chromatic aberration; an actuator operatively coupled to at least one lens for moving the at least one lens along an optical axis of the optical code reader; and a decoder for decoding data encoded by an image, as partially recited by Applicants' Claim 1, and similarly recited by Applicants' Claim 9.

Therefore, reconsideration and withdrawal of the rejection is respectfully requested and allowance of independent Claims 1 and 9 is earnestly solicited.

Dependent Claims 1-8 and 10-14 depend directly or indirectly from independent Claims 1 and 9, and are therefore patentable for at least the reasons given above for independent

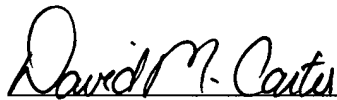
Claims 1 and 9. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested and allowance of the dependent claims is earnestly solicited

Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that none of the references of record, considered individually or in combination, in whole or in part, disclose or suggest the claimed subject matter. Therefore, all claims now pending in this application, namely, Claims 1-28, are now in condition for allowance. Accordingly, early and favorable consideration of this application is respectfully requested.

Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, he is respectfully requested to contact Applicants' undersigned attorney at the telephone number indicated below.

Respectfully Submitted,



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